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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,891	11/30/2001	Gregor Jankovic	12596-003	2776

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CANADA

EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,891

Applicant(s)

JANKOVIC, GREGOR

Examiner

John L Young

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/20/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3622

FIRST ACTION REJECTION

(Paper# 9/20/2004)

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

ABSTRACT OBJECTION

2. The ABSTRACT is objected to because it contains more than 150 words.

Appropriate corrections are required.

CLAIM OBJECTIONS—37 CFR 1.75

3. Claims 4, 12, 13, 14, 16, 17, 20, 21, 22, 23 & 24 are indefinite because of the use of the phrase “adapted to. . . .” Such language lacks positive description of functionality and/or cooperation of the various elements and limitations in said claims.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Art Unit: 3622

Whoever invents or discovers any new and useful
process, machine, manufacture, or composition of matter or
any new and useful improvement thereof, may obtain a
patent therefore, subject to the conditions and requirements
of this title.

4. Claims 9-13 & 22 are rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

As per claims 9-13 & 22, as drafted said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed Cir. 1998); *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05(q)).

Art Unit: 3622

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-24 are rejected under 35 U.S.C. §103(a) as being obvious over Focke 6,036,006 (03/14/2000) (herein referred to as "Focke").

As per independent claim 1, Focke (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-35) implicitly shows all the elements and limitations of claim 1; however,

Focke lacks explicit recitation of some of the elements and limitations of claim 1.

Art Unit: 3622

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Focke (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-35) implicitly shows those elements and limitations of claim 1 not explicitly recited, and it would have been obvious to modify and interpret the disclosure of Focke cited above as implicitly showing those elements and limitations not explicitly recited, because modification and interpretation of the cited disclosure of Focke would have provided means for “*advertising purposes. . . .*” (see Focke (the ABSTRACT)), based on the motivation to modify Focke so as to provide methods to “improve said packs in terms of the configuration and arrangement of the printing carriers. . . .” (see Focke (col. 1, ll. 35-41)).

As per dependent claims 2-8 Focke implicitly shows the method of claim 1 and subsequent base claims depending from claim 1.

Focke (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-35) implicitly shows all of the elements and limitations of claims 2-8; however,

Focke lacks explicit recitation of some of the elements and limitations of claims 2-8.

“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 2-8, were well known and expected in the art by one of

Art Unit: 3622

ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Focke cited above as showing all of the elements and limitations of claims 2-8, because modification and interpretation of the cited disclosure of Focke would have provided means for “*advertising purposes. . . .*” (see Focke (the ABSTRACT)), based on the motivation to modify Focke so as to provide methods to “improve said packs in terms of the configuration and arrangement of the printing carriers. . . .” (see Focke (col. 1, ll.35-41)).

As per independent claim 9, Focke (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-35) implicitly shows all the elements and limitations of claim 9; however,

Focke lacks explicit recitation of some of the elements and limitations of claim 9. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Focke (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-35) implicitly shows those elements and limitations of claim 9 not explicitly recited, and it would have been obvious to modify and interpret the disclosure of Focke cited above as implicitly showing those elements and limitations not explicitly recited, because modification and interpretation of the cited disclosure of Focke would have provided means for “*advertising purposes. . . .*” (see Focke (the ABSTRACT)), based on the motivation to modify Focke so as to provide methods to “improve said packs in terms of

Art Unit: 3622

the configuration and arrangement of the printing carriers. . . .” (see Focke (col. 1, ll.35-41)).

As per dependent claims 10-13 Focke implicitly shows the method of claim 9.

Focke (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-35) implicitly shows all of the elements and limitations of claims 10-13; however,

Focke lacks explicit recitation of some of the elements and limitations of claims 10-13.

“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 10-13, were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Focke cited above as showing all of the elements and limitations of claims 10-13, because modification and interpretation of the cited disclosure of Focke would have provided means for “*advertising purposes. . . .*” (see Focke (the ABSTRACT)), based on the motivation to modify Focke so as to provide methods to “improve said packs in terms of the configuration and arrangement of the printing carriers. . . .” (see Focke (col. 1, ll.35-41)).

Art Unit: 3622

As per independent claim 14, Focke (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-35) implicitly shows most of the elements and limitations of claim 14; however,

Focke lacks explicit recitation of “an advertising center coupled to said communications network, said advertising center being adapted to receive instructions regarding the advertising material from the advertiser over the communications network . . . and . . . means for delivering said advertising article to the advertiser.”

“Official Notice” is taken that both the concepts and the advantages of having “an advertising center coupled to said communications network, said advertising center being adapted to receive instructions regarding the advertising material from the advertiser over the communications network . . . and . . . means for delivering said advertising article to the advertiser. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Focke cited above as showing all of the elements and limitations of claims 10-13, because modification and interpretation of the cited disclosure of Focke would have provided means for “*advertising purposes. . . .*” (see Focke (the ABSTRACT)), based on the motivation to modify Focke so as to provide methods to “improve said packs in terms of the configuration and arrangement of the printing carriers. . . .” (see Focke (col. 1, ll.35-41)).

Art Unit: 3622

As per dependent claims 15-17 Focke implicitly shows the system of claim 14.

Focke (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-35) implicitly shows all of the elements and limitations of claims 15-17; however,

Focke lacks explicit recitation of some of the elements and limitations of claims 15-17.

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations of claims 15-17, were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Focke cited above as showing all of the elements and limitations of claims 15-17, because modification and interpretation of the cited disclosure of Focke would have provided means for "*advertising purposes. . .*" (see Focke (the ABSTRACT)), based on the motivation to modify Focke so as to provide methods to "improve said packs in terms of the configuration and arrangement of the printing carriers. . . ." (see Focke (col. 1, ll.35-41)).

Independent claim 18 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 19-21 Focke implicitly shows the method of claim 18.

Art Unit: 3622

Focke (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-35) implicitly shows all of the elements and limitations of claims 19-21; however,

Focke lacks explicit recitation of some of the elements and limitations of claims 19-21.

“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 19-21, were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Focke cited above as showing all of the elements and limitations of claims 19-21, because modification and interpretation of the cited disclosure of Focke would have provided means for “*advertising purposes. . .*” (see Focke (the ABSTRACT)), based on the motivation to modify Focke so as to provide methods to “improve said packs in terms of the configuration and arrangement of the printing carriers. . . .” (see Focke (col. 1, ll.35-41)).

Independent claim 22 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 23-24 Focke implicitly shows the method of claim 22.

Art Unit: 3622

Focke (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-35) implicitly shows all of the elements and limitations of claims 23-24; however,

Focke lacks explicit recitation of some of the elements and limitations of claims 23-24.

“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 23-24, were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Focke cited above as showing all of the elements and limitations of claims 23-24, because modification and interpretation of the cited disclosure of Focke would have provided means for “*advertising purposes. . .*” (see Focke (the ABSTRACT)), based on the motivation to modify Focke so as to provide methods to “improve said packs in terms of the configuration and arrangement of the printing carriers. . .” (see Focke (col. 1, ll.35-41)).

CONCLUSION

6. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

Art Unit: 3622

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

September 20, 2004